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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,178	08/20/2003	Robert L. Ibsen	00216-695001	9505

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EXAMINER

JAGOE, DONNA A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,178	IBSEN ET AL.	
	Examiner	Art Unit	
	Donna Jagoe	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

The amendment filed March 20, 2006 has been received and entered. Claims 1-20 canceled. New claims 21-31 are pending in this application.

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection in response to the cancellation of claims 1-20 and the addition of new claims 21-31.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 30 is directed to the non-inclusion of any non-alcoholic organic solvents. This stipulation is not found in the instant specification. In all instances, the instant specification is drawn to the exclusion of aliphatic alcoholic solvents. Claim 30 stipulates that the composition is **free of non-alcoholic solvents**; does this mean that only alcoholic solvents can be used?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker U.S. 4,602,099 and Dyer et al U.S. Patent No. 5,994,383 (reference AI from IDS dated 1/25/02).

Parker teaches a mouthwash formulation (column 5, lines 20-23) comprising inter alia water (column 5, line 48), carbomers (column 5, line 59), benzocaine (column 6, line 62) and triethanolamine (column 5, line 65). It does not teach the amounts of these agents. One skilled in the art would have been motivated to prepare additional useful compositions of the ranges taught by the prior art. While the reference is silent regarding some % ratios, the difference in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. When the general conditions are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 45, 105 USPQ 233, 235 (CCPA 1955). In the absence of any criticality and/or unexpected results of the additional ranges claimed, instant invention is considered obvious. Further, the claim language *comprising* leaves the claim open for the inclusion of unspecified ingredients, even in major amounts, and does not exclude the amounts, if any in the reference. It does not teach the triethanolamine to be a neutralizing agent. However, Dyer et al. teach that triethanolamine is a commonly used alkalination agent (column 11, lines 60-61). "Products of identical chemical composition (i.e. triethanolamine) can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical composition, the properties applicant discloses and/or claims (i.e. neutralizing or buffering) are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (Applicant argued that the claimed composition was a pressure sensitive adhesive containing a tacky

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polymer while the product of the reference was hard and abrasion resistant. "The Board correctly found that the virtual identity of monomers and procedures sufficed to support a prima facie case of unpatentability of Spada's polymer latexes for lack of novelty."). It would have been made obvious to one of ordinary skill in art at the time it was made to formulate a composition comprising benzocaine, carbomer and water in an alcohol free solvent system motivated by the teaching of Parker that teaches a mouthwash formulation that includes these agents, and Dyer et al. that teaches that triethanolamine is a commonly employed alkalination agent.

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton et al. U.S. Patent No. 5,547,657.

Singleton et al. teach a low irritation anesthetic mouth rinse (see abstract) comprising a non-alcoholic formulation (column 1, lines 60-62) of a topical anesthetic such as benzocaine (column 1, line 44, column 2, line 27) and a carbomer such as Poloxamer 407 (see example XIII and XIV, column 9). The amounts of benzocaine, carbomer and water differ from the instant invention. One skilled in the art would have been motivated to prepare additional useful compositions of the ranges taught by the prior art. While the reference is silent regarding some % ratios, the difference in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. When the general conditions are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 45, 105

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USPQ 233, 235 (CCPA 1955). In the absence of any criticality and/or unexpected results of the additional ranges claimed, instant invention is considered obvious. Further, the claim language *comprising* leaves the claim open for the inclusion of unspecified ingredients, even in major amounts, and does not exclude the amounts, if any in the reference.

Response to Arguments

Applicant asserts that Parker discloses antirhinovirus agent and various means for delivering such agents. Applicant admits that Parker does disclose a mouthwash and asserts that it is for the purpose of delivering the claimed agents. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant asserts that Parker discloses benzocaine merely as one in an extremely long list of potential agents that may be combined with the antirhinovirus agents. And carbomers are mentioned only as a possible suspending agent amongst others listed. During patent examination claims must be interpreted as broadly as they reasonably allow, in order to achieve complete exploration of applicant's invention and its relationship to prior art, so that ambiguities can be recognized, scope and breadth of language explored, and clarification imposed. Accordingly, the claim language *comprising* leaves the claim open for the inclusion of unspecified ingredients, even in major amounts.

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Regarding the Singleton reference, Applicant asserts that the agents are prepared with non-alcoholic organic solvents, such as polyethylene and propylene glycols as the sole solvents and asserts that they cannot be aqueous because of the requirement that they are freeze-thaw stable. In response, it does not state that the agents will not freeze, it only states that it is freeze-thaw stable. This is interpreted as, if the agent freezes and thaws, it will remain stable. During patent examination claims must be interpreted as broadly as they reasonably allow, in order to achieve complete exploration of applicant's invention and its relationship to prior art, so that ambiguities can be recognized, scope and breadth of language explored, and clarification imposed. Although applicant asserts that the instant invention is free of the monohydric alcohols as in Singleton, upon inspection of the applicant's instant specification, page 10, example 2 discloses an example of the alcohol-free oral rinse made using "non-alcoholic organic solvents such as propylene glycol and polyethylene glycol instead of carbomer".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

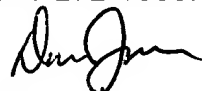
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Donna Jagoe
Patent Examiner
Art Unit 1614

May 25, 2006



ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER